

REMARKS

I. Status of Claims

Claims 96, 142, 167, 170, 175, 192, 194, 203, and 206 are pending in this application. Claims 97, 98, 101, 123, 135, 192, 194, 204, and 205 are cancelled without prejudice of disclaimer. Claims 96 and 203 are amended without prejudice or disclaimer to incorporate the species as originally filed in claims 192, 194, 204, and 205. No new matter is raised herein.

II. Rejection under § 112

The Examiner has maintained the rejection of claims 96¹-98, 101, 123, 135, 142, 167, 170, 175, 192, 194, 203, and 205-206 under 35 U.S.C. § 112, first paragraph, for lack of enablement. Specifically, the Examiner states that these claims fail to “provide enablement for providing intense color” See Office Action at 2. The Examiner concedes, however, that the specification is enabling for providing intense color using the specific polymer species of claim 204. See *id.*

While the Applicants continue to disagree for the reasons already of record, in an effort to advance prosecution, the Applicants have amended claims 96 and 203 to incorporate the species of originally filed claims 192, 194, 204, and 205, ethylenediamine/stearyl dimer tallate copolymer and ethylenediamine/stearyl dimer dilinoleate copolymer. As the Examiner acknowledges, the specification does enable a

¹ Applicants note that the Examiner lists cancelled claim 95 and assume the Examiner intended to reject pending claim 96. Applicants request notification if this assumption is in error.

method for providing intense color using ethylenediamine/stearyl dimer tallate copolymer, as now recited in amended claims 96 and 203. Moreover, contrary to the Examiner's allegation, the specification further enables a method for providing intense color in a cosmetic composition using ethylenediamine/stearyl dimer dilinoleate copolymer, as in amended claims 96 and 203. The specification provides general ranges for the various components of the inventive compositions and other such details that enable the invention, in addition to the example contained therein. See e.g., Specification at 19, 21. Moreover, as understood by a person of ordinary skill and explained in the specification, the intensity of the color is measured by the L value, where an increase in intensity of color results in a proportional decrease in the L value. See *id.* at 19. Thus, one of ordinary skill would be enabled to practice the full scope of the claimed invention without undue experimentation.

The mere fact that the specification includes testing for one species is in and of itself irrelevant to Office's erroneous conclusion of non-enablement. Rather, the courts have held that the specification need not contain any examples if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. See *In re Borkowski*, 422 F.2d 904, 908, 164 USPQ 642, 645 (C.C.P.A. 1970). In fact, the courts have instructed that a single embodiment can provide broad enablement involving well-known factors. See, e.g., *Ex parte Hitzeman*, 9 USPQ 2d 1821, 1823 (BPAI 1988), *Spectra Physics v. Coherent, Inc.*, 3 USPQ 2d 1737, 1743 (BPAI 1987). Applicants respectfully submit that the example provided in the present specification (directed to ethylenediamine/stearyl dimer tallate copolymer) enables one of ordinary skill in the art to practice the use of other

embodiments, as recited in the pending claims, without undue experimentation. At a minimum, the example also enables one to practice the invention using ethylenediamine/stearyl dimer dilinoleate, which, like the polymer of the example, is also a Uniclear[®] polyamide polymer, with Uniclear being a mixture of copolymers derived from monomers of (i) C₃₆ diacids and (ii) ethylenediamine and having terminal ester groups resulting from esterification of the remaining acid end groups with at least one alcohol chosen from cetyl alcohol and stearyl alcohol. See specification at 16-17.

For these reasons, Applicants maintain that the pending claims are enabled, and allowable. Accordingly, Applicants respectfully request that the Office withdraw the rejection under § 112, first paragraph, and allow all pending claims.

III. Rejections under § 102

The Examiner has rejected claims 96-98, 101, 123, 135, 175, and 203 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,148,125. The Examiner has also rejected claims 96-98, 101, 123, 135, 175, and 203 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No 5,500,209. The Examiner has rejected claims 96-98, 101, 123, 135, 175, and 203 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,423,324. Further, the Examiner has rejected claims 96-98, 101, 123, 135, 170, 175, and 203 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,497,861. Finally, the Examiner rejected claims 96-98, 101, 123, 135, 192, 194, and 203-206 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,402,408.

In order to anticipate the claimed invention, a reference must “teach every aspect of the claimed invention either explicitly or impliedly,” M.P.E.P. § 706.02. Further, the

reference must “clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing and combining various disclosures.” *In re Arkley*, 455 F.2d 586,587 (C.C.P.A. 1972). Importantly the absence of a single element or limitation indicates that the reference neither describes nor anticipated the claim. M.P.E.P. § 2131. Therefore, a rejection under § 102 is properly only when the claimed subject matter is identically described or disclosed in a single prior art reference. *In re Arkley*, 455 F.2d at 587.

In the present case, Applicants have amended the pending claims to incorporate the limitations of claims 203 and 204, thereby reciting that the at least one heteropolymer is chosen from ethylenediamine/stearyl dimer tallate copolymer and ethylenediamine/stearyl dimer dilinoleate copolymer. See, e.g., claims 96 and 203. Applicants submit that these specific polymers are not taught in U.S. Patent Nos. 3,148,125; 5,500,209; 6,423,324; and 6,497,861. Thus, these patents do not teach every element of the presently claimed invention, and Applicants request that the Office withdraw its rejections over this art for at least this reason.

Furthermore, Applicants submit that none of the cited references teach the presently claimed heteropolymers in an amount effective to provide intense color as in the present claims. For this additional reason, Applicants respectfully request reconsideration of the pending claims and withdrawal of all the § 102 rejections.

IV. Nonstatutory Obviousness-type Double Patenting

The Examiner has rejected claims 96-98, 101, 123, 135, 142, 170, 192, 194, and 203-206 for nonstatutory obviousness-type double patenting over claims 1 and 3 of U.S.

Patent No. 6,7116,420 and claims 1-14 of U.S. Patent No. 7,008,619. See Office Action at 16-17. The Examiner further rejected the claims over 13 additional U.S. Patents identified at pages 17 and 18 of the Office Action. Applicants respectfully request that the Examiner hold the nonstatutory obviousness-type double patenting rejection in abeyance until the Examiner has identified allowable subject matter.

V. Co-Pending Applications

As in previous submissions, for the Examiner's convenience, Applicants have provided herewith in Exhibit 1 copies of the currently pending or allowed claims from the following co-pending applications, which claims have been amended or allowed since July 9, 2007: 09/685,578; 09/733,896 (U.S. Patent No. 7,276,547); 09/733,897; 09/733,899; 09/733,900; 10/012,052; 10/203,254 (U.S. Patent No. 7,314,612); 10/450,108; 10/466,166; 10/918,579; and 11/826,997. Applicants submit these claims for the Examiner's convenience in evaluating any potential issues regarding statutory or obviousness-type double patenting.

VI. Information Disclosure Statement

Applicants thank the Examiner for acknowledging that the references listed on the IDS Forms PTO/SB/08 submitted on July 9, 2007 have been considered. For the Office's further consideration, Applicants submit a Supplemental Information Disclosure Statement herewith and respectfully request that the Office consider the cited documents and initial to indicate that they were considered.

VII. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

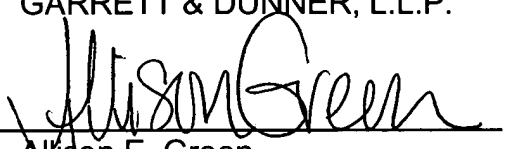
Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 11, 2008

By: _____


Allison E. Green
Reg. No. 61,692

Attachments to this amendment include:

Exhibit 1: 11 Sets of Pending Claims in Co-pending Applications